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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/795,987

03/10/2004

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23373 7590 05/08/2008  
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EXAMINER

RONESI, VICKEY M

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/08/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/795,987	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> VICKEY RONESI	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The outstanding 35 USC 112, 1<sup>st</sup> paragraph rejection is withdrawn in light of applicant's amendment filed on 2/13/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

### ***Claim Rejections - 35 USC § 103***

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Khemani et al (US 6,573,340) in view of Sonoo (JP 01-234434, full English-language translation).

The rejection is adequately set forth in paragraph 5 of Office action mailed on 11/13/2007 and is incorporated here by reference.

5. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonoo (JP 01-234434, full English-language translation) in view of Kuroki et al (US 6,462,105).

The rejection is adequately set forth in paragraph 6 of Office action mailed on 11/13/2007 and is incorporated here by reference.

***Response to Arguments***

6. Applicant's arguments filed 2/13/2008 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Khemani et al teaches away from using a composition mainly including polylactic acids; (B) that the article of Khemani et al cannot have the presently claimed density because it requires "at least one particulate filler"; (C) that Sonoo does not teach a biodegradable resin and should not be combined with Khemani et al; (D) that Kuroki et al cannot be combined with Sonoo because Kuroki et al teaches using an inorganic filler as an anti-blocking agent; and (E) that Sonoo is completely silent with respect to a polylactic acid which would provide for a large difference in heat resistance and mechanical strength.

With respect to argument (A), claim 1 is not closed off from including other ingredients as evidenced by open claim language "comprising." Therefore, the requirement of a soft biopolymer taught by Khemani et al is not outside the scope of instant claim 1.

With respect to argument (B), the hollow glass spheres of Khemani et al are the "at least one particulate filler." Hollow glass spheres help lower the density of a material because they provide bulk without weight as taught by Sonoo.

With respect to argument (C), while Sonoo does not disclose all the features of the present claimed invention, it is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, and in combination with the primary reference, discloses the presently claimed invention. Specifically, Sonoo is used to

Art Unit: 1796

build on the disclosure of Khemani et al, i.e., to provide details regarding suitable amounts, treating agents, and density when using hollow glass spheres as filler.

With respect to argument (D), while Kuroki et al does not disclose all the features of the present claimed invention, it is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, and in combination with the primary reference, discloses the presently claimed invention. Specifically, Kuroki et al is relied upon to teach that polylactic acid is an aliphatic polyester which can also be used in making molded articles like Sonoo.

With respect to argument (E), Sonoo is silent with respect to polylactic acid, however, these polymers are aliphatic polyester resins as already taught by Sonoo. Polylactic acid is a biodegradable resin that has been more readily used in recent years as taught by Kuroki et al. While at the time of Sonoo these biodegradable resin were not as common, they are now commonly used in place of non-biodegradable polyesters. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize polylactic acid as the aliphatic polyester resin in Sonoo. Furthermore, the invention of Sonoo is not based on specific heat resistance and mechanical properties and would not be improperly changed by using a polylactic acid. Rather, Sonoo is directed to a bulk molding compound with a relatively specific gravity, i.e., density.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 1796

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/5/2008

Vickey Ronesi

/V. R./

Examiner, Art Unit 1796

/VASUDEVAN S. JAGANNATHAN/

Supervisory Patent Examiner, Art Unit 1796